

a predetermined combination; and

(b) stopping a supply of power to at least one of said of at least two units in the combination when said judging part judges that the combination is the predetermined combination.

REMARKS

Introduction

In accordance with the foregoing, the claims 1, 7, 10, 11, 14, and 18 have been amended. Claims 1-19 are pending and under consideration.

More particularly, independent claims 1, 10 and 14 are amended to clarify that judging whether a combination of units is to realize a desired function is based on --an aspect of the combination of the units--. Particularly, as discussed beginning at page 17, line 3 of the application, the invention teaches that judging, for example by a CPU, can be based on identification signals indicating whether CD-ROM, DVD-ROM, hard disk, and magneto-optical drive units are connected to the apparatus, Fig. 5 showing an example of signals. As discussed beginning on page 19, line 17, this judging can be based on signals that indicate a given combination --whether a DVD decoding card is in combination with a drive unit. A table of combinations can also be referenced. (See Fig. 7 and Fig 8, and further discussion page 19, line 27 through page 20, line 29-27).

Furthermore, independent claims 7, 11, and 18 are amended to clarify that the "units" judged, with a stopping of a supply of power occurring to at least one of the units, includes --at least one PC card slot and one data driver unit--. (See, page 20, line 30 to page 21, line 2 of the application). Particularly, as discussed in the application beginning at page 20, line 1 through page 21, line 2, both PC cards and drive units can be judged, with stopping of supply of power to a drive unit and/or a PC card slot.

No new matter is added in accordance with the foregoing amendments to the above recited independent claims and, accordingly, approval and entry of the amended claims are respectfully requested.

Items 3-12: Examiner's 35 U.S.C. §102 (e) rejection of claims 1-3, 6-15, 18 and 19 as being anticipated by Nakashima (US 6,029,211)

The rejections are respectfully traversed.

Pending Claims Recite Elements and Limitations Not Disclosed In Nakashima

Anticipation (§102) requires that each and every element or limitation as set forth in a claim be described in a single prior art reference i.e. *In re Robertson*, 49

USPQ 2d 1949 (Fed. Cir. 1999). Applicant submits that Nakashima does not adequately support an anticipatory-type rejection, since elements and limitations recited in the application's independent claims are not described in the reference.

Independent claims 1, 7, 10, and 11 recite an apparatus, and claims 14 and 18, recite a method, for judging whether a combination of units is to realize a desired function. These units, as illustrated in Fig. 2 and Fig. 5 can include, for example, a CD-ROM drive unit 109, a DVD-ROM drive unit 110, a hard disk drive unit 111, and a magneto-optical disc drive unit 112.

In the present invention, as illustrated in Fig. 3 for example, base unit 101 at the PC side determines a type of driver connected to multibay 108. When it is determined that DVD ROM disk 114 is not inserted, the power is not supplied to either the PC card slot 116 or DVD drive unit 110 --even if a DVD decoding card 120; such as a PC card, is inserted into the PC slot 116. As recited in the claims, a judging part, for example, CPU 211 illustrated in Fig. 3, can control a supply of power from a power source to these units.

In addition, claims 1 and 10 (both as amended) recite a power supply control part controlling a supply of power based on a judgment, the judgment based on an aspect of the combination of units. This control of power supply, is external to the PC card --e.g., it is conducted in the base unit 101. In addition, the PC may determine the type of driver connected to this multibay 108, and utilized to control the supply of power to a PC card.

Further, claims 7, 11, and 18 (as amended) recite that the units include at least one PC card slot and one driver unit, and that the stopping of power occurs when the units are judged to be in a predetermined combination.

Applicant submits that Nakashima does not disclose, as the Examiner contends, that "only desired functions are supplied with power." Further, Nakashima does not disclose any type of "power supply" control, let alone a "power supply control part." The Examiner seems to be mistakenly equating a reduction of power consumption in a singular PC card with the present application's control of a supply of power to a plurality of varied units.

In support of the §102 rejection of claim 7, the Examiner asserts, at page 4, Item 9 of the present Office Action, that in Nakashima, "desired units ("functions") are selectively activated suggesting that units not desired are deactivated implying that the power supply is stopped to undesired unit" (emphasis added). The Examiner's own language of "suggesting" and "implying" evidences that these elements and limitations are not described by the reference, as required to support a §102 type of rejection, but rather are based on the Examiner's interpretation of same.

Nakashima only discloses a PC card with a plurality of functions, and with a switching setting element internal to the PC card. In fact, the object of Nakashima invention

--e.g., to consume less power with a single card with multiple functions --is because Nakashima lacks a power supply control external to that card, as in Applicant's invention.

Further, Nakashima does not disclose any combination of PC cards and drive units, let alone a predetermined combination, nor a control based on a combinational aspect of the units. Even assuming *arguendo* that "functions" within a PC card described in Nakashima are analogous to a plurality of units in accordance with the present invention --as the Examiner contends, but which Applicant disputes--, Nakashima does not disclose any predetermined combinations.

In addition, Nakashima does not disclose any type of judging part that judges whether a combination is a predetermined combination.

Since elements and limitations of the independent claims are not disclosed in the reference, Applicant submits the rejections should be withdrawn, and the claims allowed

Additional Grounds For Traversing the Rejection of Dependent Claims

Applicant submits that dependent claims 2, 3, 6, 8, 9, 12, 13, 15, and 19 are also allowable, based on the nondisclosure by Nakashima of elements of the respective independent claims. In addition, the dependent claims add additional features that independently distinguish over Nakashima, including the paragraphs cited by the Examiner.

For example, dependent claim 2 recites that a judging part includes both an identification information obtaining part and an information judging part. Claims 8 and 12 recite a judging part that includes a table that stores predetermined combinations of two the units, and judges whether the combination is one of the predetermined combinations based on the table. Claims 9, 13, and 19 recite a judging part that judges when the units are in a predetermined combination as an apparatus is turned on or when units are connected. Claim 15 recites obtaining identification information from a plurality of units.

Applicant submits that Nakashima does not disclose any identification information judging part, any table with predetermined combinations, or any judging part that judges such a table. In support of the §102 rejection of claim 8, the Examiner submits in the present Office Action, page 4, Item 10, that Nakashima's "data array structure is interpreted to be a table." The Examiner's own language of "interpreted" indicates the "table" element is not described by the reference.

Since elements of the dependent claims are not described in the reference, Applicant submits that the rejection should be withdrawn and the claims allowed.

Items 13-20: Examiner's 35 U.S.C. §103(a) rejection of claims 4 and 16 as being unpatentable for obviousness over Nakashima, and the 35 U.S.C. §103(a) rejection of claims 5 and 17 as being unpatentable over Nakashima in view of Beatty (US 5,781,798)

The rejections are respectfully traversed.

Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakashima.

Claim 4 recites a judging part identifying a type of device unit, and a power supply control part stopping supply of power to a PC card a judging part judges that the device unit does not use the card.

In the present Office Action, page 5, item 15, the Examiner admits that Nakashima: also does not expressly disclose the power supply control part stopping the supply of power to the card when the judging part judges that the device unit does not use the PC card. In summary, Nakashima discloses activating only the desired function selectively to reduce power consumption.

(Emphasis added).

The Examiner, however, contends that it would be obvious to stop power to an entire card when it is judged that no function on the card is used. Applicant submits, however, that Nakashima only describes an invention of a type of PC card. There is no teaching or suggestion within Nakashima to modify or construct a power supply control part.

As provided by MPEP §2143.03, entitled "All Claim Limitations Must Be Taught or Suggested, specifies: "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F. 2d 981, (CCPA 1974).

As prima facie obviousness has not been established, the rejections should be withdrawn and the claims allowed.

PAGES 5-6: REJECTION OF CLAIMS 5 AND 17 FOR OBVIOUSNESS UNDER 35 U.S.C. §103(a) OVER NAKASHIMA IN VIEW OF BEATTY

The rejection is respectfully traversed.

As to claim 5, the Examiner admits that Nakashima does not expressly disclose stopping the supply of power to the PC card when the PC card is used with a desired device that is not connected. The Examiner contends, however, that Nakashima's ability for "stopping the supply of power" may be combined with Beatty. Applicant submits, as presented above, that Nakashima does not teach stopping of supply of power.

No incentive to combine Nakashima and Beatty

In addition, there is no incentive to combine the references, whether to "detect if a device is connected to a card" as suggested by the Examiner on page 6 or for any other reason. The courts have repeatedly reaffirmed the "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Sang-Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). Applicant submits that Nakashima does not show this teaching or motivation and that the Examiner is engaging in improper hindsight reconstruction, solely in light of the teachings of the instant disclosure.

Since there is no incentive to combine the art, the rejections should be withdrawn and the claims allowed.

Even if art were combined it would not disclose, teach, or suggest application's system

Applicant submits that even assuming the cited art was combined, this combination would not perform, for example as the dependent claims recite.

As prima facie obviousness has not been established, the rejections should be withdrawn and the claims allowed.

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding rejections have been overcome. Applicant respectfully submits that all claims patentably distinguish over the prior art, and that the applied art, taken alone or in any proper combination, does not support a §103 obviousness type rejection. Thus, there being no further outstanding objections or rejections, the application is submitted to be in condition for allowance, which action is earnestly solicited.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,
STAAS & HALSEY LLP

Date: May 5, 2003

By: H. J. Staas
H. J. Staas
Registration No. 22,010

700 Eleventh Street, NW, Suite 500
Washington, D.C. 20001
(202) 434-1500

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please AMEND the following claims:

1. (once amended) An electronic apparatus [for realizing a desired function by combining a plurality of units], comprising:

a judging part judging whether a combination of [the] a plurality of units is to realize [said] a desired function; and

a power supply control part controlling a supply of power from a power source to at least one of said units of said combination used to realize said desired function based on a [judgement] judgment result of the judging part, based on an aspect of said combination of the plurality of units.

7. (once amended) An electronic apparatus connectable to a plurality of units including at least one PC card slot and one driver unit, comprising:

a judging part judging whether a combination of at least two of said plurality of units is a predetermined combination; and

a power source control part stopping a supply of power to at least one unit in the combination when said judging part judges that the combination is the predetermined combination.

10. (once amended) A power control apparatus for an electronic apparatus [which realizes a desired function by combining a plurality of units], comprising:

a judging part judging whether a combination of [said] a plurality of units is to realize said desired function; and

a power supply control part controlling a supply of power from a power source to said units of said combination used to realize said desired function based on a [judgement] judgment result of said judging part, wherein said judgment is based on an aspect of said combination of the plurality of units.

11. (once amended) A power control apparatus for an electronic apparatus connectable to a plurality of units including at least one PC card slot and one driver unit, comprising:

a judging part judging whether or not a combination of at least two of said plurality of units is the predetermined combination ; and

a power control part stopping a supply of power to at least one unit of the predetermined combination when it is judged that the combination is the predetermined combination.

14. (once amended) A method for controlling a supply of power in an electronic apparatus [that realizes a desired function by combining a plurality of units], comprising [the steps of]:

(a) judging whether a combination of the plurality of units is to realize said desired function and practicing a judgment result; and

(b) controlling a supply of power from a power source to at least one of said units of said combination used to realize said desired function based on [a judgement] the judgment result [in step (a)] , wherein said judgment is based on an aspect of said combination of the plurality of units.

18. (once amended) A method for controlling a supply of power in an electronic apparatus connectable to a plurality of units including at least one PC card slot and one driver unit , comprising [the steps of]:

(a) judging whether a combination of at least two units of said plurality of units is a predetermined combination; and

(b) stopping a supply of power to at least one of said of at least two units [unit] in the combination when said judging part judges that the combination is the predetermined combination.